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10/091,424	03/07/2002	Evan R. Kirshenbaum	10015991-1	8876

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EXAMINER
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AGWUMEZIE, CHARLES C

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/091,424

Applicant(s)

KIRSHENBAUM ET AL.

Examiner

Charlie C. Agwumezie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03/07/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1-9, 12-15, 19-21, and 27-33**, are rejected under 35 U.S.C. 102(e) as being anticipated by Vanska et al U.S. Patent 2002/0147766.

1. As per **claim 1, 21, 32 and 33**, Vanska et al discloses a system for customer-side market segmentation while preventing disclosure of sensitive customer information, comprising:

a non-merchant-controlled device having a means for customer categorization, the categorization being based on a business-specific decision procedure and stored customer information, wherein the customer information is kept private from merchants based on specified criteria (see fig. 3A; 6A; & 7A and B; 0038, 0039, 0040, 0065);

a first merchant-controlled means for providing the business-specific decision procedure to the non-merchant-controlled device (see fig. 1 and 6A and B); and  
a second merchant-controlled means for receiving a category code from the non-merchant-controlled device (see fig. 1, 6A and B, 0094).

2. As per **claim 2**, Vanska et al further discloses the system, further comprising customer-controlled means for specifying the criteria used to keep information private (fig. 3A; 0032).
3. As per **claim 3**, Vanska et al further discloses the system, wherein the business-specific decision procedure is provided to the non-merchant-controlled device over a public, global communication network and the category code is also sent over the public, global communication network from the non-merchant-controlled device (see fig. 1A, 2 and 7A and B).
4. As per **claim 4**, Vanska et al further discloses the system, wherein the first and second merchant-controlled means are integrated as one physical unit as a promotional device (fig. 1B; 0029).
5. As per **claim 5**, Vanska et al further discloses the system, wherein the non-merchant-controlled device is a customer-controlled device (see fig. 3A).
6. As per **claim 6**, Vanska et al further discloses the system, wherein the non-merchant-controlled device is a third-party-controlled device (see figs. 5, 6A and B).
7. As per **claim 7**, Vanska et al further discloses the system, wherein customer

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identification is masked to prevent identification of the customer by a merchant (0034, 0035, 0036 and 0037).

8. As per **claim 8**, Vanska et al further discloses the system, wherein the first merchant-controlled means selects the third-party-controlled device from a plurality of third-party devices based on customer preferences (see fig. 6A and B, 0054).

9. As per **claim 9**, Vanska et al further discloses the system, wherein the first merchant-controlled means device provides identification information to the non-merchant-controlled device, and wherein the non-merchant-controlled device utilizes configurable safeguards combined with the provided identification to prevent undesirable release of customer information (figs. 3A, 6A and B; 0032, 0106).

12. As per **claim 12**, Vanska et al further discloses the system, wherein the first merchant-controlled means device further comprises a proximity detector for detecting the presence of a non-merchant-controlled device (fig. 8A; 0061, 0075, 0077, 0079, 0147).

13. As per **claim 13**, Vanska et al further discloses the system, wherein the non-merchant-controlled device queries the customer for additional information responsive to receipt of the business-specific decision procedure (see fig. 8B; 0147).

14. As per **claim 14**, Vanska et al further discloses the system, wherein the non-merchant-controlled device comprises a portable device and a personal computer (PC), the PC providing means for entering additional information requested by the query, wherein the additional information entered into the PC is transferred to the portable device at the request of the customer, and wherein the portable device is used for interaction with the promotional device (figs. 3A and B; 0028).

15. As per **claim 15**, Vanska et al further discloses the system, wherein the non-merchant-controlled device further comprises means for performing sensitivity analysis on the business-specific decision procedure, thereby determining whether sensitive information is to be revealed to a merchant based on the categorization (0033, 0034, 0035, 0036 and 0037).

19. As per **claim 19**, Vanska et al further discloses the system, wherein the non-merchant-controlled device is a customer-controlled personal digital assistant (PDA) (0028).

20. As per **claim 20**, Vanska et al further discloses the system, wherein the non-merchant-controlled device queries the customer for additional information responsive to receipt of a business-specific decision procedure, and wherein the PDA provides means for entering additional information requested by the query (figs. 6A-B, 8 A -D).

27. As per **claim 27**, Vanska et al further discloses the method, further comprising steps of: querying the customer for additional information by the non-merchant-controlled device, responsive to receiving a business-specific decision procedure; and inputting additional information by the customer, wherein the additional information is added to the stored customer-specific information for use by the categorizer (0006, 0033, 0129, 0149, 0015).

28. As per **claim 28**, Vanska et al further discloses the method, further comprising steps of: capturing additional information related to the customer, wherein the additional information comprises at least one item selected from the group consisting of customer behavior, outside factors, and customer mode; and expanding the stored customer-specific information with the additional information, wherein the additional information is used by the categorizer to provide an updated customer category (fig. 3A; 0009, 0033, 0038, 0039, 0040, 0108).

29. As per **claim 29**, Vanska et al further discloses the method, wherein the non-merchant-controlled device is a third-party controlled device (figs. 5, 6A and 6B).

30. As per **claim 30**, Vanska et al further discloses the method, further comprising: providing promotional material to the customer by a business, wherein the business provides the business-specific decision procedure received by the third-party-controlled

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device, and wherein the promotional material is customized based on the identified customer category (see figs. 5, 6A and B; 7A and B).

31. As per claim 31, Vanska et al further discloses the method, further comprising steps of: performing sensitivity analysis on the decision procedure to safeguard sensitive information, by the customer (0005, 0007, 0013, 0039).

34. As per claim 34, Vanska et al further discloses the computer readable medium, further comprising a fourth code section for determining a preferred action based on the customer category received (fig. 7A and B; 0033, 0039, 0058).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10 and 11**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanska et al U.S. Patent Application Publication 2002/0147766 in view of Ginter et al U.S. Patent 6,185,683.



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10. As per **claim 10**, Vanska et al failed to explicitly disclose the system, wherein the identification information uses an identity token.

Ginter et al discloses the system, wherein the identification information uses an identity token (col. 8, lines 15-22).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system wherein the identification information uses an identity token in view of the teachings of Ginter et al in order to ensure adequate security.

11. As per **claim 11**, Vanska et al failed to explicitly disclose the system, wherein the identification information uses a digital certificate.

Ginter et al discloses the system, wherein the identification information uses a digital certificate (col. 80, lines 10-19).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system wherein the identification information uses a digital certificate in view of the teachings of Ginter et al in order to ensure adequate security.

**Claims 16-18, and 22-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanska et al U.S. Patent Application Publication 2002/0147766 in view of Katz et al U.S. Patent Application Publication 2003/0130904.

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16. As per claim 16, Vanska does not teach the system, wherein the business-specific decision procedure masks rules and resulting categories to prevent reverse-engineering of the decision procedure. The examiner takes Official Notice that it is old, conventional and notoriously well known in the art that companies mask or hide their business rules to avoid reverse engineering. It is often difficult if not impossible to reverse engineer software or software application by simply looking at the input and output as in the present claimed invention.

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system wherein the business-specific decision procedure masks rules and resulting categories to prevent reverse-engineering of the decision procedure in order to avoid reverse engineering.

17. As per claim 17, Vanska et al failed to explicitly disclose the system, further comprising means for providing promotional material to a customer.

Katz et al discloses the system, further comprising means for providing promotional material to a customer (0078, 0094).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system, further comprising means for providing promotional material to a customer in view of the teachings of Katz et al in order to induce customers.

18. As per claim 18, Vanska et al failed to explicitly disclose the system, wherein the means for providing promotional material comprises a printing device

Katz et al discloses the system, wherein the means for providing promotional material comprises a printing device (0078).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system, wherein the means for providing promotional material comprises a printing device in view of the teachings of Katz et al in order to induce customers at the store.

22. As per claim 22, Vanska et al failed to explicitly disclose the method, further comprising: providing promotional material to the customer by a business, wherein the business provides the business-specific decision procedure received by the non-merchant-controlled device, and wherein the promotional material is customized based on the identified customer category.

Katz et al discloses the method, further comprising: providing promotional material to the customer by a business, wherein the business provides the business-specific decision procedure received by the non-merchant-controlled device, and wherein the promotional material is customized based on the identified customer category (see fig. 6; 0028, 0078, 0094).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system,

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wherein the business provides the business-specific decision procedure received by the non-merchant-controlled device, and wherein the promotional material is customized based on the identified customer category in view of the teachings of Katz et al in order to ensure that only potential interested customer are targeted.

23. As per **claim 23**, Vanska et al failed to explicitly disclose the method, wherein the promotional material is selected from a group consisting of discount coupons, advertisements, product information, business information; competitor comparisons, product comparisons, special offers and feedback requests.

Katz et al discloses the method, wherein the promotional material is selected from a group consisting of discount coupons, advertisements, product information, business information; competitor comparisons, product comparisons, special offers and feedback requests (0078, 0010, 0012).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system, wherein the promotional material is selected from a group consisting of discount coupons, advertisements, product information, business information; competitor comparisons, product comparisons, special offers and feedback requests in view of the teachings of Katz et al in order to ensure alternative means of attracting potential interested customer.

24. As per **claim 24**, Vanska et al failed to explicitly disclose the method, wherein

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promotional information is printed at a business location and provided to a customer shopping at the business location.

Katz et al discloses the method, wherein promotional information is printed at a business location and provided to a customer shopping at the business location (0078).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Vanska et al and provide a system, wherein promotional information is printed at a business location and provided to a customer shopping at the business location in view of the teachings of Katz et al in order to reduce cost of manufacture and distribution.

25. As per claim 25, Vanska et al further discloses the method, wherein the non-merchant-controlled device is a customer-controlled device (see fig. 3A).

26. As per claim 26, Vanska et al further discloses the method, wherein promotional information is displayed on the customer-controlled device (0063, 0130).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is (703) 305-0586. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

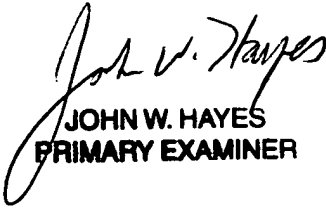
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305 – 9768. The fax phone number for the organization where the application or proceeding is assigned is (703) 305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

acc

February 14, 2005

  
JOHN W. HAYES  
PRIMARY EXAMINER